

Appln. No. 10/622,945
Amendment dated November 8, 2004
Reply to Office Action mailed September 27, 2004

REMARKS

Reconsideration is respectfully requested.

Claims 1, 2 and 5 through 9 remain in this application. Claims 3 and 4 have been cancelled.

The Examiner's rejections will be considered in the order of their occurrence in the Office Action.

Paragraphs 2 and 3 of the Office Action

Claims 1-5 have been rejected under 35 U.S.C. §102(b) as being anticipated by US 2003/0010371A1 to Langley.

It is submitted that the Langley reference does not disclose, teach or suggest "each of said side walls having a plurality of ventilation holes extending through said respective side wall, said ventilation holes being positioned proximate said top wall of said housing such that said ventilation holes are adapted for exhausting warm exhaled air from the user for preventing the exhaled breath from fogging said window panel". The Langley reference teaches a portable rain seat enclosure that fails to teach each of the side walls having a plurality ventilation holes positioned proximate the top wall to allow warm air exhaled by the user to be vented from the interior space of the housing to inhibit fogging of the window panel as claimed by the applicants. Attention is directed to the last sentence of paragraph 34 of the Langley reference, reiterated below.

"Ventilation is provided by a number of vents (not shown) in the panels."

Thus, the Langley reference is completely silent on the location of the vents and therefore fails to meet the requirements of the claims of the applicants. Further, for claims to be anticipated by a reference that reference must describe every element of those claims as well as those elements must be arranged as is required by the claims as expressed in MPEP 2131 stated below.

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"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim, but this is not an *ipse dixit* test, i.e., identity of terminology is not required. In *re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990). Note that, in some circumstances, it is permissible to use multiple references in a 35 U.S.C. 102 rejection. See MPEP § 2131.01."

Therefore, it is submitted that the Langley reference would not lead one to anticipate the combination of features as claimed by the applicants.

Claims 2 and 5 are dependent upon claim 1, particularly as amended, and therefore incorporate the requirements of claim 1. Thus, claims 2 and 5 are also believed to be allowable over the cited reference.

Claims 3 and 4 have been cancelled.

Withdrawal of the §102(b) rejection of claims 1-5 is therefore respectfully requested.

Paragraph 4 of the Office Action

Claims 1, 6 and 7 have been rejected under 35 U.S.C. §102(b) as being anticipated by US Patent Re. 29,264 to Woodward.

It is submitted that the Woodward reference does not disclose, teach or suggest "each of said side walls having a plurality of ventilation holes extending through said respective side wall, said ventilation holes being positioned proximate said top wall of said housing such that said ventilation holes are adapted for exhausting warm exhaled air from the user for preventing the exhaled breath from fogging said window panel". The Woodward reference teaches a tent for rear-doored vehicle that fails to

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teach each of the side walls having a plurality ventilation holes positioned proximate the top wall to allow warm air exhaled by the user to be vented from the interior space of the housing to inhibit fogging of the window panel as claimed by the applicants. Therefore, it is submitted that the Woodward reference would not lead one to anticipate the combination of features as claimed by the applicants.

Claims 6 and 7 are dependent upon claim 1, particularly as amended, and therefore incorporate the requirements of claim 1. Thus, claims 6 and 7 are also believed to be allowable over the cited reference.

Withdrawal of the §102(b) rejection of claims 1, 6 and 7 is therefore respectfully requested.

Paragraph 5 of the Office Action

Claims 1-3, 5 and 8 have been rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent 3,491,781 to Reese.

It is submitted that the Reese reference does not disclose, teach or suggest "each of said side walls having a plurality of ventilation holes extending through said respective side wall, said ventilation holes being positioned proximate said top wall of said housing such that said ventilation holes are adapted for exhausting warm exhaled air from the user for preventing the exhaled breath from fogging said window panel". The Reese reference teaches a collapsible seating enclosure that fails to teach each of the side walls having a plurality ventilation holes positioned proximate the top wall to allow warm air exhaled by the user to be vented from the interior space of the housing to inhibit fogging of the window panel as claimed by the applicants. Therefore, it is submitted that the Reese reference would not lead one to anticipate the combination of features as claimed by the applicants.

Claims 5 and 8 are dependent upon claim 1, particularly as amended, and therefore incorporate the requirements of claim 1. Thus, claims 5 and 8 are also believed to be allowable over the cited reference.

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Claim 3 has been cancelled.

Withdrawal of the §102(b) rejection of claims 1-3, 5 and 8 is therefore respectfully requested.

Paragraph 6 of the Office Action

Claims 1-3 and 5 have been rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent 3,052,251 to De Jean Jr.

It is submitted that the De Jean, Jr. reference does not disclose, teach or suggest "each of said side walls having a plurality of ventilation holes extending through said respective side wall, said ventilation holes being positioned proximate said top wall of said housing such that said ventilation holes are adapted for exhausting warm exhaled air from the user for preventing the exhaled breath from fogging said window panel". The De Jean, Jr. reference teaches a spectator shelter that fails to teach each of the side walls having a plurality ventilation holes positioned proximate the top wall to allow warm air exhaled by the user to be vented from the interior space of the housing to inhibit fogging of the window panel as claimed by the applicants. Therefore, it is submitted that the De Jean, Jr. reference would not lead one to anticipate the combination of features as claimed by the applicants.

Claims 2 and 5 are dependent upon claim 1, particularly as amended, and therefore incorporate the requirements of claim 1. Thus, claims 2 and 5 are also believed to be allowable over the cited reference.

Claim 3 has been cancelled.

Withdrawal of the §102(b) rejection of claims 1-3 and 5 is therefore respectfully requested.

Paragraphs 7 and 8 of the Office Action

Claim 4 has been rejected under 35 U.S.C. Section 103(a) as being unpatentable over U.S. Patent 3,052,251 to De Jean Jr. in view of U.S. Patent 4,716,918 to Hayashida et al.

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The law regarding obviousness is clear--any modification of the prior art must be suggested or motivated by the prior art:

'Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under section 103, teachings of references can be combined only if there is some suggestion or incentive to do so.' [citation omitted] Although couched in terms of combined teachings found in the prior art, the same inquiry must be carried out in the context of a purported obvious "modification" of the prior art. The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification.

In re Fritch, 972 F.2d 1260; 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992), (in part quoting from ACS Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 1577; 221 USPQ 929, 933 (Fed. Cir. 1984)).

It is submitted that the combination of De Jean, Jr. with Hayashida is not suggested by the prior art, and even if such a combination were to be made, one would not be led to the combination of features recited in applicants' claims. In particular, the references do not disclose, teach or suggest "each of said side walls having a plurality of ventilation holes extending through said respective side wall, said ventilation holes being positioned proximate said top wall of said housing such that said ventilation holes are adapted for exhausting warm exhaled air from the user for preventing the exhaled breath from fogging said window panel". As discussed above, the De Jean, Jr. reference fails to teach each of the side walls having a plurality ventilation holes positioned proximate the top wall to allow warm air exhaled by the user to be vented from the interior space of the housing to inhibit fogging of the window panel as claimed by the applicants. The Official Action attempts to meet the requirements of the claims by combining the air outlet openings in the head end of the tent of the Hayashida reference with structure of the De Jean, Jr. reference when there is no motivation for such a combination provided by the references. It is further submitted that when a suggestion or motivation to combine

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selected elements of prior art references is not supplied by the prior art, the incentive to make such a combination can only come from improper hindsight reconstruction using the applicants' specification.

As this court has stated, "virtually all [inventions] are combinations of old elements." *Environmental Designs, Ltd. v. Union Oil Co.*, 713 F.2d 693, 698, 218 USPQ 865, 870 (Fed. Cir. 1983); *see also Richdel, Inc. v. Sunspool Corp.*, 714 F.2d 1573, 1579-80, 219 USPQ 8, 12 (Fed. Cir. 1983) ("Most, if not all, inventions are combinations and mostly of old elements."). Therefore an examiner may often find every element of a claimed invention in the prior art. If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue. Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be "an illogical and inappropriate process by which to determine patentability." *Sensonics, Inc. v. Aerosonic Corp.*, 81 F.3d 1566, 1570, 38 USPQ 2d 1551, 1554 (Fed. Cir. 1996).

In re Rouffet, 47 USPQ 2d 1453, 1457 (Fed. Cir. 1998)

Therefore, it is submitted that the combination of the De Jean, Jr. reference with the Hayashida reference would not lead one to the combination of features as claimed by the applicant.

Claim 4 has been cancelled.

Withdrawal of the §103(a) rejection of claim 4 is therefore respectfully requested.

Paragraph 9 of the Office Action

Claims 6 and 7 have been rejected under 35 U.S.C. Section 103(a) as being unpatentable over U.S. Patent 3,052,251 to De Jean Jr. in view of U.S. Patent Re. 29,264 to Woodward.

The law regarding obviousness is clear--any modification of the prior art must be suggested or motivated by the prior art:

'Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under section 103, teachings

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of references can be combined only if there is some suggestion or incentive to do so.' [citation omitted] Although couched in terms of combined teachings found in the prior art, the same inquiry must be carried out in the context of a purported obvious "modification" of the prior art. The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification.

In re Fritch, 972 F.2d 1260; 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992), (in part quoting from ACS Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 1577; 221 USPQ 929, 933 (Fed. Cir. 1984)).

It is submitted that the combination of De Jean, Jr. with Woodward is not suggested by the prior art, and even if such a combination were to be made, one would not be led to the combination of features recited in applicants' claims. In particular, the references do not disclose, teach or suggest "each of said side walls having a plurality of ventilation holes extending through said respective side wall, said ventilation holes being positioned proximate said top wall of said housing such that said ventilation holes are adapted for exhausting warm exhaled air from the user for preventing the exhaled breath from fogging said window panel". As discussed above, the De Jean, Jr. and Woodward references fail to teach each of the side walls having a plurality ventilation holes positioned proximate the top wall to allow warm air exhaled by the user to be vented from the interior space of the housing to inhibit fogging of the window panel as claimed by the applicants. Therefore, it is submitted that the combination of the De Jean, Jr. with the Woodward reference would not lead one to the combination of features as claimed by the applicant.

Claims 6 and 7 are dependent upon claim 1, particularly as amended, and therefore incorporate the requirements of claim 1. Thus, claims 6 and 7 are also believed to be allowable over the cited reference.

Withdrawal of the §103(a) rejection of claims 6 and 7 is therefore respectfully requested.

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Paragraph 10 of the Office Action

Claim 9 has been rejected under 35 U.S.C. Section 103(a) as being unpatentable over U.S. Patent 3,052,251 to De Jean Jr. in view of U.S. Patent 4,716,918 to Hayashida et al further in view of U.S. Patent Re. 29,264 to Woodward.

The law regarding obviousness is clear--any modification of the prior art must be suggested or motivated by the prior art:

'Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under section 103, teachings of references can be combined only if there is some suggestion or incentive to do so.' [citation omitted] Although couched in terms of combined teachings found in the prior art, the same inquiry must be carried out in the context of a purported obvious "modification" of the prior art. The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification.

In re Fritch, 972 F.2d 1260; 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992), (in part quoting from ACS Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 1577; 221 USPQ 929, 933 (Fed. Cir. 1984)).

It is submitted that the combination of De Jean, Jr. with Woodward is not suggested by the prior art, and even if such a combination were to be made, one would not be led to the combination of features recited in applicants' claims. In particular, the references do not disclose, teach or suggest "each of said side walls having a plurality of ventilation holes extending through said respective side wall, said ventilation holes being positioned proximate said top wall of said housing such that said ventilation holes are adapted for exhausting warm exhaled air from the user for preventing the exhaled breath from fogging said window panel". As discussed above, the De Jean, Jr. and Woodward references fail to teach each of the side walls having a plurality ventilation holes positioned proximate the top wall to allow warm air exhaled by the user to be vented from the interior space of the housing to inhibit fogging of the window

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panel as claimed by the applicants. The Official Action attempts to meet the requirements of the claims by combining the air outlet openings in the head end of the tent of the Hayashida reference with structure of the De Jean, Jr. reference when there is no motivation for such a combination provided by the references. It is further submitted that when a suggestion or motivation to combine selected elements of prior art references is not supplied by the prior art, the incentive to make such a combination can only come from improper hindsight reconstruction using the applicants' specification.

As this court has stated, "virtually all [inventions] are combinations of old elements." *Environmental Designs, Ltd. v. Union Oil Co.*, 713 F.2d 693, 698, 218 USPQ 865, 870 (Fed. Cir. 1983); *see also Richdel, Inc. v. Sunspool Corp.*, 714 F.2d 1573, 1579-80, 219 USPQ 8, 12 (Fed. Cir. 1983) ("Most, if not all, inventions are combinations and mostly of old elements."). Therefore an examiner may often find every element of a claimed invention in the prior art. If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue. Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be "an illogical and inappropriate process by which to determine patentability." *Sensonic, Inc. v. Aerosonic Corp.*, 81 F.3d 1566, 1570, 38 USPQ 2d 1551, 1554 (Fed. Cir. 1996).

In re Rouffet, 47 USPQ 2d 1453, 1457 (Fed. Cir. 1998)

Therefore, it is submitted that the combination of the De Jean, Jr. reference with the Woodward and Hayashida references would not lead one to the combination of features as claimed by the applicants.

Withdrawal of the §103(a) rejection of claim 9 is therefore respectfully requested.


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CONCLUSION

In light of the foregoing amendments and remarks, early reconsideration and allowance of this application are most courteously solicited.

Respectfully submitted,

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